



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,754	09/15/2003	William J. Veeneman	12051/US	1542

7590 06/25/2009
Devan V. Padmanabhan
DORSEY & WHITNEY LLP
Intellectual Property Department
50 South Sixth Street, Suite 1500
Minneapolis, MN 55402-1498

EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
----------	--------------

3687

MAIL DATE	DELIVERY MODE
-----------	---------------

06/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/662,754		VEENEMAN, WILLIAM J.	
	Examiner		Art Unit	
	VANEL FRENEL		3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 3/17/09. Claims 1, 2, 23, 33, 43, 57, 63, 64, 70 and 72-75 have been amended. Claims 76-89 have been newly added. Claims 1-89 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 12, 23, 33, 43, 48, 57, 63, 64, and 70 recite the claimed invention is directed to non-statutory subject matter.

4. Claims 1, 12, 23, 33, 43, 48, 57, 63-64 and 70 recite a process comprising the steps of: indicating gift items for purchase, indicating a plurality of entities, associating each gift and providing a machine readable code. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements

is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeRoy et al. (5,970,474).

As per claims 1-89, LeRoy discloses "In a gift registration system", a method of conveying gift registration information to a gift buyer, the method comprising: indicating gift items for purchase (See LeRoy, Col.1, lines 15-40); indicating a plurality of entities

Art Unit: 3687

where the gift items may be purchased (See LeRoy, Col.5, lines 10-41); associating each gift item with an entity where the gift item may be purchased (See LeRoy, Col.5, lines 41-67). Examiner takes Official Notice that providing a machine readable code associated with a registrant is old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the method of LeRoy. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of allowing registrants to register gift requests in a national database which is updatable to reflect customer purchases so that other customers can search the database from any location in the country and retrieve a current list to avoid making duplicate purchases.

As per claim 2, LeRoy discloses the method wherein the machine-readable code is a bar code (See LeRoy, Co1.3, lines 45-49).

As per claim 3, LeRoy discloses the method, wherein indicating the plurality of entities includes showing a name associated with an entity (See LeRoy, Col.8, lines 11-24).

As per claim 4, LeRoy discloses the method, wherein the name is shown logo form (See LeRoy, Col.7, lines 35-67).

As per claim 5, LeRoy discloses the method further comprising providing an image (See LeRoy, Col.7, lines 35-52).

As per claim 6, LeRoy discloses the method wherein the image is of a gift item (See LeRoy, Col.5, lines 41-67).

As per claim 7, LeRoy discloses the method further comprising indicating a purchase price associated with a gift item (See LeRoy, Col.1, lines 14-46).

As per claim 8, LeRoy discloses the method further comprising providing a reduced price associated with a gift item (See LeRoy, Col.7, lines 1-40).

As per claim 9, LeRoy discloses the method further comprising indicating a gift registration's location (See LeRoy, Col.8, lines 11-20).

As per claim 10, LeRoy discloses the method wherein a gift item is indicated by providing parameters that can be used to guide a purchase by the gift buyer (See LeRoy, Col.6, lines 44-67).

As per claim 11, LeRoy discloses the method wherein a gift item is indicated by providing preferred alternatives from which the gift buyer may purchase (See LeRoy,

Art Unit: 3687

Col.6, lines 44-67).

Claims 12-89 repeat the same limitations as claim 1, are therefore rejected for the same reasons given above and incorporated herein.

Response to Arguments

7. Applicant's arguments filed on 3/17/09 with respect to claims 1-89 have been fully considered but they are not persuasive.

(A) At pages 10-12 of the response filed on 3.17/09, Applicant argues the followings:

(i) The rejection under 35 U.S.C 101 should be withdrawn.

(ii) LeRoy does not disclose a) "information concerning which retail stores in a 'network' sell which gift items; b) "indicating a plurality of entities where the gift items may be purchased and associating each gift item with an entity where the gift item may be purchased".

(iii) LeRoy does not disclose a card.

(B) With respect to Applicant first argument, the Examiner respectfully submitted that the 101 rejection should be sustained because the claimed invention is still directed to non-statutory matter. Here, the state of the law with respect to statutory subject matter eligibility under 101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent, a proper process must be tied to another statutory class or

transform underlying subject matter to a different state or thing (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584,588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876)).

Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second argument, the Examiner respectfully submitted He relied upon the teaching of LeRoy (See Col.2, lines 13-41; Col.8, lines 11-39) for such a feature. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

8. With respect to Applicant third argument, the Examiner respectfully submitted that He relied upon the teaching of LeRoy for such a feature (See Col.5, lines 42-67). Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

Art Unit: 3687

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Examiner, Art Unit 3687

June 16, 2009